

I. REMARKS

This Amendment is responsive to the non-final rejections articulated by the Examiner in the Office Action dated June 15, 2005. As Applicant explained in the Pre-Prosecution Amendment filed on March 1, 2004, for the purposes of provoking an interference with U.S. Patent No. 6,539,680 to Kunz ("the '680 patent"), which was filed on September 28, 2001 and issued on April 1, 2003, Applicant's Claims 31-34 have been, in substance, copied from Claims 1-4 of the '680 patent. The term "corner" has been substituted for the '680 patent term "nose," the term "flap" substituted for "wing," the term "flange" substituted for "leg" and the term "the" for the term "said." In view of this fact, Applicant respectfully urges allowance of Claims 31-34 copied from Claims 1-4 of the Kunz '680 patent. In accordance with M.P.E.P. § 2307.02, Applicant respectfully submits that the arguments presented herein establish that Applicant's presently pending Claims 31-36 and newly added Claims 37 and 38 are allowable over the cited art, and that a formal notice of allowance is in order.

For some background information, the Examiner will recall that, U.S. Patent Appl. Ser. No. 09/933,229, to which the present application claims priority, was filed on August 20, 2001. After issuing an allowance in that case, the assigned Examiner subsequently withdrew it and issued a final rejection of the pending claims. The claims of U.S. Patent Application Ser. No. 10/338,511 also claiming priority to U.S. Patent Appl. Ser. No. 09/933,229 were finally rejected and, on September 14, 2005, Applicant filed its Appeal

Brief, to support its Appeal in that case. In none of those related applications were Miller or Tucker cited.

In the present application, Claims 31-39 remain pending, with Claim 31 being an independent apparatus claim and Claim 35 being an independent method claim. The Examiner has rejected Claims 31-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,090,087 to Miller (hereinafter "Miller" or "the Miller patent") in view of U.S. Patent No. 4,863,774 to Tucker (hereinafter "Tucker" or "the Tucker patent"). The Examiner has rejected method Claims 35-36 under 35 U.S.C. § 103(a) in view of these same references.

The Examiner has also objected to the drawings in view of the fact that the specification did not provide a description for element 28 in the figures, and objected to Claim 33 for providing an insufficient antecedent basis for "the central corner portion" limitation and objected to the specification for not listing the patent number for Appl. Serial No. 09/825,766. Element 28 has been added at page 9, the word "central" deleted from Claim 33 and U.S. Patent No. 6,655,101 added to the Specification.

Applicant respectfully submits that the amendments to the specification and claims presented above obviate the Examiner's objections. Applicant further submits that the arguments presented herein traverse the Examiner's claim rejections, demonstrating the pending claims are patentably distinct from the cited combination of the Miller and

Tucker patents and that the Examiner has failed to carry her burden of demonstrating a *prima facie* case of obviousness.

II. ARGUMENTS

A. Applicant's Disclosure

The Applicant's invention is directed to a tape-on drywall finishing device of the type typically wrapped about the corner where two drywall panels join and is secured in place by joint compound on the drywall panels beneath paper flaps 50 which projecting laterally from the opposite lateral edges of, for instance, a bull nose rigid core 40 typically constructed of metal. In the preferred embodiment, the flaps are processed by knurling wheels as shown in Fig. 6 to form longitudinally extending depressions which are configured with inwardly projections as shown in Fig. 3 intended to embed in compound underneath the flaps. This construction offers the unique advantage of serving to positively anchor the flaps, and consequently, the accessory firmly to the drywall panels.

Claims 31 and 35 include the limitations of a paper strip covering the core strip and projecting beyond the edges to form flaps which are configured with spaced apart uniform dept depressions projecting from the inward face to be embedded in joint compound. Both claims have been amended in this regard to bring out what was already inherent in the original claims and which are not intended to in any way act as further limitations on such claims. As will be noted, from the disclosure and the original claims

calling for the projection from the inward face of the flap, the fact of embedding in the joint compound was at all times inherent in these claims.

B. Miller

Miller proposes a stock material for edging strips which may be rolled into a roll and which includes "adhering to a pliable lengthwise looped flat carrier web a single comparatively stiff metal web of a width less than the width of the carrier web" (Col. 2, lines 40-43). He proposes that the metal strip be flat but bendable along a longitudinal groove 11 which will permit rolling of the metal web, together with the carrier web (Col. 3, lines 9-10) into a roll but upon unrolling can be bent to form orthogonal flanges and marginal strips 13a. He provides that the marginal strips 13a of the carrier web be coated with a suitable adhesive and that after being applied to the corner, the edging strip be secured by means of the "overhanging adhesive-coated marginal portions 13a of the carrier web." (Col. 3, lines 44-45).

In her rejection of independent Claims 31 and 35, the Examiner relied on the Miller patent as the base reference for teaching the majority of Applicant's claim limitations, admitting that Miller does not disclose "uniform depressions on the flap."

In each instance, the Examiner then relies on the Tucker patent to provide this missing limitation, for example arguing that "Tucker teaches that it is known in the art to provide the flaps (as at 82) of a drywall accessory with uniform depressions (20, 22)" and, from this she argues it would have been obvious to provide the flaps of Miller with

"the uniform depressions in the order to improve adhesion of the device to the drywall."

It is far from intuitive as to how this would be done to achieve Applicant's results.

C. The Proposed Combination

As stated in M.P.E.P. § 2143.01, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). As explained in further detail below, Applicant submits that the Miller and Tucker references relied upon by the Examiner cannot render Applicant's claims obvious because their teachings actually make it clear that one skilled in the art would be dissuaded from making their combination. As M.P.E.P. § 2143.01 goes on to explain, "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

D. Tucker

Tucker is directed to a paper corner tape with orthogonal flanges and having a raised exterior flexible bead 14, 44, 120 or 130 (Figs. 11 and 12) glued to the exterior corner thereof as shown in Fig. 3 to provide a longitudinal, outwardly spaced distal surface such that a layer of plaster 34 may be applied over the entire corrugated "backing strip 82" by troweling or the like to provide the triangular cross sectional configuration as shown in Fig. 3. The tape 10 is said to include an elongated strip 12 of porous flexible paper which is corrugated transversely throughout its length to form a series of

alternating furrows 20 and ridges 22 to provide peripheral edges of side margins 16 and 18 with folds which may be expanded and contracted in accordion like fashion to allow the margins to conform to a variety of corner configurations of intersecting drywall panels. (Col. 5, lines 13-22). Tucker is less than explicit as to how he fabricates the embodiment of Fig. 7 referred to by the Examiner but does state that he includes a sector of arcuate plastic tubing to form a bead sector 64 and includes drywall tape 80 identical to tape 60 (Col. 6, lines 63-67) which is referred to as porous flexible backing material (Col. 6, lines 43-44). He then states the tape 80 is transversely corrugated.

Tucker then states that the drywall tape 10 is held in position on the intersecting drywall panels 24 and 26 "by wet plaster 34, which is spread upon the side margins 16 and 18 so as to permeate the material of the backing strip 12." (Fig. 3, Col. 5, lines 45-47). The plaster 34 "provides a firm protective bullwork for the plaster" and serves to prevent the plaster from being exposed at the corner apex which would typically lead to crumbling of the plaster 34. One particular feature stressed by Tucker is that with the accordion like construction, the tape 20 may be curved to be easily applied to a curved overhead arch way 38 (Fig. 4) to conform to the curvature of such arch way (Col. 5, lines 55-57). Tucker exhibits his preference for paper tape and denigrates more rigid metal beading as being capable of only conforming "to straight linear edges formed by orthogonal sections of drywall panels" (Col. 2, lines 21-23) as they "do not always readily lay flat against the surfaces of the drywall" (Col. 2, lines 26-29) and "will rust" (Col. 2, line 41). He emphasizes that with his accordion ribbon or strip, "the strength of

the tape is increased by approximately a factor of ten as contrasted with conventional drywall tape formed only on the same backing material." (Col. 2, lines 55-57).

E. Miller and Tucker Attach Differently

Thus, Miller relies on carrier web carrying a metal core strip medially with flanking marginal strips 13a adhered by adhesive or plastic over the outside surface while Tucker specifically seeks to avoid metal, preferring accordion type paper to afford high strength and flexibility. Tucker's motivation for the furrows is to provide lateral strength and longitudinal flexibility. Applicant's motivation for depressions is totally different.

F. It Is Not Shown How The Combination Is To Be Made

The Examiner states, without proof, that it would have been obvious to form uniform depressions in the flaps of Miller to improve adhesion. To the contrary, Miller teaches planar flanges and margin 13a, with adhesive on the interior of the margins which perform better when there is adhesive contact throughout a continuous plane, not with accordion like lateral corrugations. The Examiner fails to demonstrate how she perceives the corrugations in Tucker's orthogonal flanges would be incorporated into Miller. To achieve Tucker's flexibility it would be necessary to corrugate Miller's metal core strip thus defeating Miller's objective of a flat core. If the Examiner intended to argue, however, that there is some suggestion that only the margins 13a projecting to the sides of the metal strip 10, as adhered to by adhesive 15 shown in Fig. 7, of Miller be corrugated, it must be recognized that she has failed to account for the fact one skilled in the art would anticipate that applying accordion furrows and ridges 20 and 22 of Tucker

would reduce the longitudinal length of the paper. If such application of lateral configurations were post adhesion of the core to the carrier strip, one of skill would expect the paper to rip and tear and/or pull away from the core strip 10 as its length is reduced relative to the inelastic core. On the other hand, if the Examiner intended to argue it would be practical to apply the lateral corrugations before affixing of the core to the carrier strip, she again fails to account for the fact Miller, seeking good adhesive contact or embedding in plaster (Col. 3, lines 26-28), would prefer a planar surface both for attachment of the core to the carrier strip and for attachment of the strip to the drywall. To corrugate the marginal strips 13a laterally would be to reduce the adhesive contact area thus defeating a purpose of Miller. In any event, there is no showing that the ridges on the exterior face of Tucker, even if they could be incorporated in Miller, would serve his alternative attachment function of "imbedding" in cement.

The only evidence on the issue of obviousness in making the proposed combination is from Applicant's disclosure and U.S. Patent No. 6,539,680 to Kunz. But then Kunz, not just skilled in the art but an inventor, did not deem the combination obvious when he filed his earlier patent application on May 17, 2000 leading to issuance of U.S. Patent No. 6,295,776. It will also not escape the Examiner's attention that neither Miller nor Tucker were cited against the Kunz '680 patent. In any event, it will be appreciated that the evidence of record points clearly to nonobviousness of the combination and fails to show that, even if combined, Applicant's results would be achieved.

Claim 33 recites the accessory of Claim 31 in the form of a corner bead with the paper strip including a flap projecting transversely from each flange. There is no showing of how Tucker should be combined with Miller to provide such a flap with inward projections as claimed.

Claim 34 specifically recites the core strip as being metal, the material denigrated by Tucker.

Claim 37 includes all the limitations of claim 31 with the additional limitation that the depressions run longitudinally. This is totally contrary to Tucker. Tucker specifically requires the lateral accordion like effect for accommodating curvatures as in the archway shown in Fig. 4 of its patent. As noted in Applicant's disclosure, the elongated depressions typically add to the beam stiffness of the flaps and thus adding to the longitudinally stiffness, totally contrary to Tucker.

Claim 39 recites deformation of the flap after attached to the core to form longitudinal depressions. The additional benefit of this construction is that, when so deformed, after prior bonding to the core, the paper flap is shortened slightly along its length causing it to draw the relatively flexible metal core laterally in one direction at the opposite ends thereof toward what will be the drywall panel to thus form a very slight bowed curvature. This bowed curvature is helpful in facilitating attachment of a drywall corner bead to a drywall surface, such as orthogonal drywall corners in that, the flanges of the core being bowed slightly in at the ends, can merely be positioned by the workman

grasping it intermediate the ends to press it bodily against the drywall itself thus tending to, as he or she presses inwardly, straightening the bead to maintain positive uniform contact with the drywall throughout the length thereof.

From the foregoing, it will be apparent that Applicant has made a valuable contribution to the art and that the evidence of record clearly demonstrates that Applicant's claim construction and method was not obvious to those working in the art. It is believed that the claims are now in condition for allowance and early notice thereof is respectively solicited.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

By:



Vern Schooley

Registration No. 24,649

200 Oceangate, Suite 1550
Long Beach, California 90802
Telephone: (562) 432-0453
Facsimile: (562) 435-6014
Customer No. 27629
VS/ABL/rmk